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| 09/612.789 | 07/10/2000 | Satyan G. Pitroda | 2683/79382 | 9381 |
| 24628 | 7590 | 01/17/2006 | EXAMINER | |
| WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606 | | | TRINH, TAN H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2684 | |

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,789

Applicant(s)

PITRODA, SATYAN G.

Examiner

TAN TRINH

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-13-2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Gaillard (U.S. Pub. No. 20030028458).

Regarding to claim 1, Gaillard teaches a method of exchanging payment information in an electronic transaction, comprising:

a) a first electronic transaction device transferring payment information to a second electronic transaction device (See figs. 1 and 3, first electronic transaction device's item 28 (PPITCD (smart card) 28) and second electronic transaction device's item 12 (debit machine 12) and page 2, session [0019-0020]).

b) the second electronic transaction device transferring value information to the first electronic transaction device (See figs. 1 and 3, second electronic transaction device's item 12 transferring value information (see fig. 1, 236.75\$) to first electronic transaction device's item 28, and page 2, session [0021-0022]).

c) the second electronic transaction device transferring value information and payment information to a service consolidation center (see figs. 1 and 3, second electronic transaction

Art Unit: 2684

device's item 12 and information to a service consolidation center item 18 (Financial Institution), and page 2, session [0026]). And (See page 8, sessions [0237-0247]).

Regarding to claims 2 and 3, Gaillard teaches the value information comprises a virtual card (see fig. 1, items 20 and 34, and page 8, sessions [0230-231 and page 11, sessions [00280-0292]), authorization code (see page 9, session [0250]).

Regarding to claim 8, Gaillard teaches the payment information comprises credit payment information (see page 1, session [0005]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaillard (U.S. Pub. No. 20030028458) in view of Resnick (U.S. Pub. No. 20010001321).

Regarding to claim 4, Gaillard teaches wherein the virtual card comprises an image (see fig. 1, image on display 34). But Gaillard fails to teach an image of a card.

However, since Gaillard teaches the virtual card comprises an image of the value information; this is obvious to the image of a card.

Art Unit: 2684

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Gaillard system with the teaching of image on virtual card, so that user can visual the image of the card easier.

Regarding claim 5, Gaillard teaches the value information (see figs. 1 and 3). But Gaillard fails to teach a quantity of minutes corresponding to pre-paid telephone account.

However, Resnick teaches a quantity of minutes corresponding to pre-paid telephone account (see page 1, session [0004], lines 1-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Gaillard system and by the teaching of Resnick on pre-paid telephone account thereto in order to provide user with the convenience for prepaid wireless service.

Regarding to claim 6, Gaillard teaches the payment information (see fig. 1). But Gaillard fails to teach the cash payment information.

However, Resnick teaches the cash payment information (see fig. 2, page 1, session [0003] and session [0006]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Gaillard system and by the teaching of Resnick on cash payment thereto in order to provide the convenience for user with cash payments at a multitude of merchant locations.

Regarding to claim 7, the cash payment information includes an identification of a person is providing a cash payment. That is obvious to create a trace of their subscriber and created a profile for each subscriber whether they use cash or credit card.

5. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaillard (U.S. Pub. No. 20030028458) in view of Fournies (U. S. Pub. No. 20010021648).

Regarding to claim 9, Gaillard teaches the method of exchanging payment information in an electronic transaction (see figs 1 and 3), but Gaillard fails to show the method of tracking retail sales of pre-paid cards to cash subscribers.

However, Fournies teaches the method of tracking retail sales of pre-paid cards to cash subscribers. (see page 6, section [0058]) comprising:

a); an entering value purchased information and subscriber information in a retailer electronic transaction device (see page 7, section [0059] and page 7, section [0066],

b) the retailer electronic transaction device transferring the value purchased information and subscriber information to a mobile operator (see page 7, section [0068], lines 1-3),

c) the mobile operator adding value corresponding to the value purchased information to an account corresponding to the subscriber information (see page 7, section [0068], lines 14-18) page 8, section [0070] and page 7, section [0063]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Gaillard system with the providing of the teaching of

Art Unit: 2684

Fougnies in the pre-paid cards technique there to in order to provide user with convenient to pay monthly access fees and to purchase additional air time with pre-paid cards.

Regarding to claim 10, Gaillard teaches the step of entering value purchased information and subscriber information in a retailer electronic transaction device further comprises electronically transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (See figs. 1 and 3, first electronic transaction device's item 28 (PPITCD (smart card) 28) and second electronic transaction device's item 12 (debit machine 12) and page 2, session [0019-0020]).

Regarding to claim 11, Gaillard teaches the step of entering value purchased information and subscriber information in a retailer electronic transaction device further comprises manually entering the value purchased information and subscriber information into the retailer electronic transaction device (see page 1, session [0005]).

6. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arditti (U.S. Patent No. 5,99,413) in view of Gaillard (U.S. Pub. No. 20030028458).

Regarding to claim 12, Arditti d teaches a method of distributing virtual pre-paid cards (see fig. 1, col. 1, lines 30-61), and creating virtual transaction card (see col. 5, lines 4-59). But Arditti fails to teach downloading the virtual pre-paid card to the retail electronic transaction device, and transferring virtual pre-paid card from the retail electronic transaction device to MO subscriber handset.

Art Unit: 2684

However, Gaillard teaches downloading the virtual pre-paid card to the retail electronic transaction device (See figs. 1 and 3, first electronic transaction device's item 28 (PPITCD (smart card) 28) and second electronic transaction device's item 12 (debit machine 12) and page 2, session [0019-0020]), and transferring virtual pre-paid card from the retail electronic transaction device to MO subscriber handset (See figs. 1 and 3, second electronic transaction device's item 12 transferring value information (see fig. 1, 236.75\$) to first electronic transaction device's item 28, and page 2, session [0021-0022]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Arditti and Gaillard system with the providing of the teaching of in the pre-paid cards technique there to in order to provide user with convenient to pay the virtual pre-paid card to the retail electronic device.

Regarding to claim 13, Gaillard teaches the step of transferring payment information from the MO subscriber handset to the retailer electronic transaction device (see fig. 1, Amount payable 237.75 \$ US.).

Regarding to claim 14, Arditti d teaches the step of creating a virtual card is performed by an electronic transaction device service center (see fig. 1 item 1 and col. 4, lines 25-59).

Regarding to claim 15, Gaillard teaches the steps of transferring payment information and subscriber information from the MO subscriber handset to the retailer electronic transaction device; and transferring the payment information and subscriber information from the retailer

Art Unit: 2684

electronic transaction device to the electronic transaction device service center (see figs. 1 and 3, second electronic transaction device's item 12 and information to a service consolidation center item 18 (Financial Institution), and page 2, session [0026]). And (See page 8, sessions [0237-0247]).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arditti (U.S. Patent No. 5,99,413) in view of Gaillard (U.S. Pub. No. 20030028458), further in view of Fournies (U. S. Pub. No. 20010021648).

Regarding to claim 16, Arditti or Gaillard fails to teach the steps of downloading the virtual card to a retailer electronic transaction device occurs via a MO switch.

However, Fournies teaches the steps of downloading the virtual card to a retailer electronic transaction device occurs via a MO switch (see fig. 1 item 20 L.E.C and fig. 8A-B cellular switch 204 and page 8, section [0051]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Arditti and Gaillard system with the providing of the teaching of Fournies on transaction device occurs via a MO switch technique there to in order to provide user with convenient to use cell phone to downloading the virtual card to a retailer electronic.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arditti (U.S. Patent No. 5,99,413) in view of Gaillard (U.S. Pub. No. 20030028458), further in view of Tushie (U.S. Patent No. 6,202,155).

Regarding to claim 17, Arditti or Gaillard fails to teach the step of downloading batches of virtual transaction cards to the retailer electronic transaction device.

However, Tushie teaches the step of creating a virtual card comprises creating a plurality of virtual cards and the step of downloading the virtual card to a retailer electronic transaction device comprises downloading batches of virtual transaction cards to the retailer electronic transaction device (see figs. 1-2 and 6A-B, col. 1, lines 29-40, col. 2 lines 51-67 and col. 3 lines 1-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Arditti and Gaillard systems and by the providing of the teaching of Tushie on the downloading batches of virtual transaction cards technique thereto in order provide the issuer to identify the easier.

Response to Arguments

9. The amendment filed on 10-31-2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Gaillard (U.S. Pub. No. 20030028458) reference.

10. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the June 28, 2000 of the Provisional application No. 60/214,436 of Gaillard (U.S. Pub. No. 20030028458) reference.

Art Unit: 2684

Therefore, the examiner contends that Gaillard is a proper prior art against the present application.

Conclusion

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for Technology Center 2600 only)

*Hand-delivered responses should be brought to the Customer Service Window (now located at the **Randolph Building, 401 Dulany Street, Alexandria, VA 22314**).*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (571) 272-7888. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Nay Maung, can be reached at (571) 272-7882.

The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

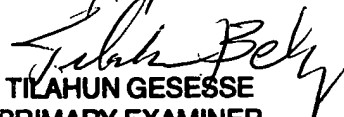
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

Art Unit: 2684

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh
Art Unit 2684
Dec. 29, 2005



1/10/06

TILAHUN GESESSE
PRIMARY EXAMINER